

## REMARKS

Claims 1-16 are pending in this application, and under consideration. Claims 1, 8, 15, and 16 have been amended. Support for the amendments to the claims may be found in the specification as originally filed at page 4, lines 8-16. This amendment is believed to place the application in condition for allowance, and entry therefore is respectfully requested. In the alternative, entry of this amendment is requested as placing the application in better condition for appeal by, at least, reducing the number of issues outstanding. Further reconsideration is requested based on the foregoing amendment and the following remarks.

### Response to Arguments:

The Applicants appreciate the consideration given to their arguments. The Applicants, however, are disappointed that their arguments were not found to be persuasive. The final Office Action asserts in section 2, in the last full paragraph at page 2, that:

It is a well-settled rule that a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. See *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979) and *In re Lamberti*, 545 F.2d 747, 192 USPQ 278, (CCPA 1976) as well as *In re Bode*, 550 F.2d 656, 193 USPQ 12, (CCPA 1977) which indicates such fair suggestions to unpreferred embodiments must be considered even if they are not illustrated.

This is submitted to be incorrect. While "a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests," *In re Burckel*, it must still "fairly suggest" that its teachings should be modified as proposed in the final Office Action. Nothing in *In re Bode* indicates fair suggestions to unpreferred embodiments must be considered even if they are not *illustrated*, contrary to the assertion in the final Office Action. Rather, in *Bode*, a drawing was not *required* in U.S. Patent No. 3,559,190 to Blitzler, but Blitzler still had to teach or *suggest* the claimed invention.

The final Office Action asserts further in section 2, also in the last full paragraph at page 2, that:

Additionally, it is an equally well-settled rule that what a reference can be said to fairly suggest relates to the concepts fairly contained therein, and is not limited by the specific structure chosen to illustrate such concepts. See *In re Bascom*, 230F.2d 612, 614, 109 USPQ 98, 100 (CCPA 1956).

Even in *Bascom*, however, the overriding question to be determined is whether those concepts would have suggested to one skilled in the art the modification called for by the claims. See *In re Bascom*, 230F.2d 612, 614, 109 USPQ 98, 100 (CCPA 1956).

Obviousness, rather, cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). A suggestion, teaching or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." *C.R. Bard, Inc. v. MP3 Sys., Inc.*, 157 F.3d 1340, 1352 (Fed. Cir. 1998). "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Furthermore, the suggestion must be clear and particular; broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120 (Fed. Cir. 2000). "The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies." *In re Lee*, 277 F.3d 1338, 1344, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

Finally, as provided in M.P.E.P. § 2143.03, all claim limitations must be taught or suggested.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Here, neither Kuroda nor Higashiura teach, disclose, or suggest a management device that "registers and revises the content on the portable medium and stores a processing history of said registration processing or a revision processing and the media ID for the content in relation to each other into said storage unit," as recited in, for example, claim 1.

The final Office Action asserts, in the second full paragraph at page 3, that:

Kuroda teaches the content can be stored in a storage, such as a magnetic disk drive, and optical disk unit, magneto-optic -disk equipment, a memory card, a floppy disk, CD-ROM, an optical disc and a magneto-optic disc (sections 79-85 on pages 52-53). Kuroda discloses such storage is used as the document storage section storing documents (section 82 on page 52). This teaches documents can be stored in a storage, such as a portable medium, separately from document management information. Therefore, Kuroda teaches a content is removed from the management device via a portable medium.

This is submitted to be incorrect. Even though JP 2001-117820 to Kuroda *et al.* (hereinafter "Kuroda") does allow storage of the secure archive (SA) on external storage 115, as noted in the final Office Action, the registration and revision processing and the content are maintained on

the *same* secure archive at all times. Nothing in Kuroda teaches that the registration and revision processing and the content would *ever* be separated, let alone stored separately. In particular, as described in paragraph [0016], at page 33:

It unites with an electronic filing document and the registration information specified from applications, such as the attribute of P8: next the original, or copy, and the management information which SAs, such as attributes, such as a copy and original, and the date and time of creation, manage uniquely are treated. Thus, application is unifying an electronic filing document, management information, and registration information independently, and even if a document moves, it will become possible to refer to the attribute of the electronic original at a migration place.

Thus, in Kuroda, in contrast to the claimed invention, the registration and revision processing and the content are maintained on the same secure archive at all times. If the external storage 115 of Kuroda is used, it contains the program and data, and the entire secure archive is stored to external storage document storage section 36. In particular, as described in paragraph [0082], at page 52:

External storage 115 is a magnetic disk drive, an optical disk unit, magneto-optical disk (magneto-optical disk) equipment, etc. The information processor saves an above-mentioned program and data at this external storage 115, and can load and use them for memory 112 if needed. Moreover, external storage 115 is used also as the document storage section 36 of drawing 4, and the physical ID creation section 37.

Thus, in Kuroda, in contrast to the claimed invention, if the content is stored on external storage 115, the registration and revision processing information is stored there as well.

Finally, even if Kuroda *did* teach that "content was removed from the *management device* via the portable medium," as asserted in the final Office Action in the last line of the second full paragraph at page 3, with emphasis added, that still would not amount to the registration and revision processing and the content being stored separately. Rather, it would only mean that both the content and the registration and revision processing information were stored together on a portable medium such as external storage 115.

Nevertheless, in the interest of compact prosecution only, and not for any reason of patentability, the sixth clause of claim 1, for example, has been amended to recite:

Wherein the portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device.

Neither Kuroda nor Higashiura teach, disclose, or suggest "the portable medium containing the content is removed from the management device while the processing history and

the media ID remain in the management device," as recited in claim 1. Thus, even if Kuroda and Higashiura were combined, as proposed in the final Office Action, the claimed invention would not result.

The final Office Action asserts in the fifth paragraph at page 4, that:

Thus, Higashiura teaches storing the content in a portable medium separately from the content management information. Specifically, in fig. 10A, the content management information of the documents A, B, and C is stored in the first storage medium, and the documents A, B, and C are stored in another storage medium, not the first storage medium. Also, the sweep history file shown in fig. 4 is stored separately from the storage medium storage documents, such as documents A, B, and C. Therefore, Higashiura also teaches the portable medium containing the content is removed from a management device.

Since, as noted in the final Office Action, the sweep history file shown in Fig. 4 is stored *separately* from the storage medium storage documents, the sixth clause of claim 1, for example, has been amended to recite:

Wherein the portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device.

Figs. 10A and 10B of Higashiura, moreover, show a *restoring* process, not a storing process, let alone a "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as now recited in claim 1. In particular, as described at paragraph [0047]:

FIGS. 10A and 10B show the restoring process (2) when a file having a sweep history is detected when the restoring process is performed.

Moreover, in Higashiura, the sweep history file is stored on *another* medium, as discussed above, rather than "the processing history and the media ID remain in the management device," as now recited in claim 1. In particular, as described at paragraph [0084]:

In FIG. 10A, the documents A, B, and C are swept into another storage medium, and the information that the documents A, B, and C have been swept is stored on the first storage medium. At this time, the sweep history file is stored on another medium.

Higashiura, in fact, is about storing histories of revisions separately from documents to determine which electronic file is an original document. In particular, as described in paragraph [0037]:

According to the present invention, when an electronic file is processed, for example, when an electronic file is swept and a backup electronic file is made,

these histories are stored, and it can be clearly determined which electronic file is an original document. Therefore, only one original document is stored, and can be discriminated from a file stored in a storage unit or a storage medium different from that storing the original document, thereby successfully managing the electronic file without damaging the originality of the original document.

Since Higashiura is about storing histories of revisions separately from documents to determine which electronic file is an original document, Higashiura has no "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as recited in claim 1.

In addition, since Higashiura describes document D, the current content information, being left in the first storage medium at paragraph [0081], as shown in Fig. 6A, and then sharing the first storage medium with document E, as shown in Fig. 6B, along with information about the previously swept documents A through C, "the processing history and the media ID" in Higashiura do not "remain in the management device," as now recited in claim 1.

Furthermore, since, as noted with bold type in the final Office Action, in the third full paragraph at page 4, another storage medium also stores a sweep history file in Higashiura, "the processing history and the media ID" in Higashiura do not "remain in the management device," as now recited in claim 1.

Finally, since, as also noted in bold type in the final Office Action, the sweep history file, which is also content management information, is stored on another medium, "the processing history and the media ID" in Higashiura do not "remain in the management device," as now recited in claim 1. Further reconsideration is thus requested.

#### **Claim Rejections - 35 U.S.C. § 103:**

Claims 1, 2, 3, 5, 6, 7, 8-12, 14, 15, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Patent Abstracts of Japan Publication No. 2001-117820 to Kuroda et al. (hereinafter "Kuroda") in view of U.S. Publication No. 2002/0002561 to Higashiura et al. ("Higashiura"). The rejection is traversed to the extent it might apply to the claims as amended. Further reconsideration is earnestly solicited.

In the claimed invention, in several embodiments, a processing history of electronic content is stored on a management device while the content itself is stored on a removable (external) storage device. This allows the space available to store the electronic content to be expanded easily, as the volume of the electronic content increases, by simply replacing the removable storage device with a larger one. To this end, the sixth clause of claim 1 recites:

Wherein the portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device.

Neither Kuroda nor Higashiura teach, disclose, or suggest a “portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device,” as recited in claim 1.

In Kuroda, rather, as shown in Fig. 1, the electronic original management equipment itself is equipped with the registration means 1, the grant means 2, a management tool 3, and the issue means 4, so no “portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device,” as recited in claim 1. The electronic original management equipment of Kuroda thus manages and stores the processing history *and* the content inside. In particular, as described at paragraph [0006]:

The electronic original management equipment of drawing 1 is equipped with the registration means 1, the grant means 2, a management tool 3, and the issue means 4.

Since, in Kuroda, the electronic original management equipment manages and stores the processing history and the content inside, no “portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device,” as recited in claim 1.

Furthermore, in Kuroda, the electronic original management equipment manages *both* the original information and the electronic intelligence. In particular, as described at paragraph [0007]:

In the 1st aspect of affairs of this invention, the registration means 1 registers electronic intelligence as original information, and the grant means 2 gives the logical identifier information which identifies electronic intelligence uniquely logically, and the whereabouts identification information showing the physical whereabouts of electronic intelligence to the electronic intelligence. A management tool 3 manages original information using the combination identification information based on the combination of logical identifier information and whereabouts identification information, and the issue means 4 publishes registration bond information that it is used for access to original information, including the combination identification information.

Since, in Kuroda, the original information and the electronic intelligence are both managed by the electronic original management equipment, no “portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device,” as recited in claim 1.

Furthermore, in Kuroda, the electronic original 14 is only *exchanged* using the secure medium 16. In particular, as described at paragraph [0018]:

The service client 12 and SA11 are connected to the communication network, and the service client 12 accesses the electronic original 14 in SA11 using the document record 15 published from SA11 at the time of electronic original registration. Moreover, in the case of network connection, in the exchange between SAs11, the electronic original 14 is exchanged like the service client 12 and the communication link between SAs11 using the document record 15. In the case of off-line, the electronic original 14 is exchanged using the secure medium 16.

Since, in Kuroda, the electronic original 14 is only exchanged using the secure medium 16, no "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as recited in claim 1.

Furthermore, in Kuroda, the electronic original 14 is only exchanged using the secure medium 16. In particular, as described at paragraph [0019]:

The local environment 13 of a service client side is a system which guarantees safeties (original nature), such as the only nature of the electronic original, in its one post, office, etc. in a firm, and contains local SA21 and a user terminal 22. Original nature is guaranteed only within the local environment 13, and the electronic original managed in local SA21 is not linked with the electronic original in other SAs11. Between local SA21 and external SA11, the information on the electronic original can be exchanged through a communication network or the secure medium 16.

Since, in Kuroda, the electronic original 14 is only exchanged using the secure medium 16, no "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as recited in claim 1.

Furthermore, in Kuroda, SA11 contains the original sequence Management Department 34 as well as the document storage section 36. In particular, as described in paragraph [0020], at page 34:

Drawing 4 is the block diagram of SA11 of drawing 3. SA11 of drawing 4 is equipped with a network interface 31, the demand interpretation section 32, the answerback creation section 33, the original sequence Management Department 34, the registration bond creation section 35, the document storage section 36, physical ID creation section 37, the cipher-processing section 38, the key attaching part 39, the discernment ID creation section 40, the time-of-day generation section 41, the equipment ID attaching part 42, and the incremental counter 43.

Thus, in Kuroda, in contrast to the claimed invention, the registration and revision processing and the content are maintained on the same secure archive at all times.

Furthermore, in Kuroda, the SA holds the instance of the original at the time, whenever a condition changes, and it manages a series of instances as an original sequence. In particular, as described in paragraph [0034], at page 37:

Next, management of an original sequence is explained. As for the original registered into SA, the condition changes with actuation of updating, migration, deletion, etc. SA holds the instance of the original at the time, whenever a condition changes, and it manages a series of instances as an original sequence. And the original sequence ID is given to the original sequence, and it identifies uniquely. Thereby, if it sees from a service client, it will become possible to specify the sequence as the one original and to take it out.

Thus, in Kuroda, in contrast to the claimed invention, the registration and revision processing and the content are maintained on the same secure archive at all times.

Furthermore, in Kuroda, whenever a change of state happens, an instance like the electronic filing documents is held in the secure archive. In particular, as described in paragraph [0036], at page 37:

Then, if correction etc. is made on an electronic filing document D1, the condition of the original changes and re-registration is performed, SA will generate the instance of the electronic filing document D 1-2 which makes SID1 the original sequence ID, and will hold it. Henceforth, whenever a change of state happens, an instance like the electronic filing documents [ D / D, D / 1-4 /, and / 1-5 ] 1-3 is held, and a series of instances are identified by SID1.

Thus, in Kuroda, in contrast to the claimed invention, the registration and revision processing and the content are maintained on the same secure archive at all times.

Furthermore, in Kuroda, SA holds the instance of the original and manages a series of instances as an original sequence. In particular, as described at paragraph [0034]:

Next, management of an original sequence is explained. As for the original registered into SA, the condition changes with actuation of updating, migration, deletion, etc. SA holds the instance of the original at the time, whenever a condition changes, and it manages a series of instances as an original sequence. And the original sequence ID is given to the original sequence, and it identifies uniquely. Thereby, if it sees from a service client, it will become possible to specify the sequence as the one original and to take it out.

Since, in Kuroda, SA holds the instance of the original and manages a series of instances as an original sequence, no "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as recited in claim 1.



Furthermore, in Kuroda, SA will give SID1 to an electronic filing document D 1-1 as an original sequence ID, and will manage it as an original sequence S1. In particular, as described at paragraph [0035]:

Drawing 7 shows signs that an original sequence is uniquely identified according to the original sequence ID. If an electronic filing document D1 is registered into SA as an electronic filing document D 1-1, SA will give SID1 to an electronic filing document D 1-1 as an original sequence ID, and will manage it as an original sequence S1.

Since, in Kuroda, SA will give SID1 to an electronic filing document D 1-1 as an original sequence ID, and will manage it as an original sequence S1, no "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as recited in claim 1.

Furthermore, in Kuroda, if correction etc. is made on an electronic filing document D1, the condition of the original changes and re-registration is performed, SA will generate the instance of the electronic filing document D 1-2 which makes SID1 the original sequence ID, and will hold it. In particular, as described at paragraph [0036]:

Then, if correction etc. is made on an electronic filing document D1, the condition of the original changes and re-registration is performed, SA will generate the instance of the electronic filing document D 1-2 which makes SID1 the original sequence ID, and will hold it. Henceforth, whenever a change of state happens, an instance like the electronic filing documents [ D / D, D / 1-4 /, and / 1-5 ] 1-3 is held, and a series of instances are identified by SID1.

Since, in Kuroda, if correction etc. is made on an electronic filing document D1, the condition of the original changes and re-registration is performed, SA will generate the instance of the electronic filing document D 1-2 which makes SID1 the original sequence ID, and will hold it, no "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as recited in claim 1.

Finally, in Kuroda, the external storage 115, if used, contains the program and data and entire secure archive is stored to external storage document storage section 36. In particular, as described in paragraph [0082], at page 52:

External storage 115 is a magnetic disk drive, an optical disk unit, magneto-optical disk (magneto-optical disk) equipment, etc. The information processor saves an above-mentioned program and data at this external storage 115, and can load and use them for memory 112 if needed. Moreover, external storage 115 is used also as the document storage section 36 of drawing 4, and the physical ID creation section 37.

Thus, in Kuroda, in contrast to the claimed invention, the registration and revision processing and the content are maintained on the same secure archive at all times. This also means that Kuroda has no need for storing "a processing history of said registration processing or said revision processing and the media ID for the content in relation to each other into said storage unit," as also recited in claim 1, since the registration and revision processing and the content of Kuroda are maintained *together* on the same secure archive at all times.

Higashiura shows no "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," either, as discussed above. Thus, even if Kuroda nor Higashiura were combined, as proposed in the final Office Action, claim 1 would not result. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 2, 3, 5, 6, and 7 depend from claim 1 and add additional distinguishing elements. Claims 2, 3, 5, 6, and 7 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2, 3, 5, 6, and 7 is earnestly solicited.

Claims 8-12 and 14:

The last clause of claim 8 recites:

Wherein the second storage unit containing the content is removed from the management device while the processing history and the media ID remain in the management device.

Neither Kuroda nor Higashiura teach, disclose, or suggest a "second storage unit containing the content is removed from the management device while the processing history and the media ID remain in the management device," as discussed above with respect to claim 1. Claim 8 is thus also submitted to be allowable, for at least those reasons discussed above with respect to claim 1. Withdrawal of the rejection of claim 8 is earnestly solicited.

Claims 9-12 and 14 depend from claim 8 and add additional distinguishing elements. Claims 9-12 and 14 are thus also submitted to be allowable. Withdrawal of the rejection of claims 9-12 and 14 is earnestly solicited.

Claim 15:

The last clause of claim 15 recites:

The external storage unit containing the content is removed from the management device while the processing history and the media ID remain in the management device.

Neither Kuroda nor Higashiura teach, disclose, or suggest an "external storage unit containing the content is removed from the management device while the processing history and the media ID remain in the management device," as discussed above with respect to claim 1. Claim 15 is thus also submitted to be allowable, for at least those reasons discussed above with respect to claim 1. Withdrawal of the rejection of claim 15 is earnestly solicited.

Claim 16:

The last clause of claim 16 recites:

The external storage unit containing the content is removed from the management device while the processing history and the media ID remain in the management device.

Neither Kuroda nor Higashiura teach, disclose, or suggest an "external storage unit containing the content is removed from the management device while the processing history and the media ID remain in the management device," as discussed above with respect to claim 1. Claim 16 is thus also submitted to be allowable, for at least those reasons discussed above with respect to claim 1. Withdrawal of the rejection of claim 16 is earnestly solicited.

Claims 4 and 13:

Claims 4 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuroda and Higashiura in view of U.S. Patent Publication No. 2002/0169973 to Kim et al. (hereinafter "Kim"), and further in view of U.S. Patent No. 6,249,866 to Brundrett et al. (hereinafter "Brundrett"). The rejection is traversed to the extent it might apply to the claims as amended. Reconsideration is earnestly solicited.

Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuroda in view of Higashiura and U.S. Publication No. 2002/0169973 to Kim et al. ("Kim"), and further in view of U.S. Patent No. 6,249,866 to Brundrett et al. ("Brundrett").

Claim 4 depends from claim 1 and adds additional distinguishing elements. Neither Kuroda nor Higashiura teach, disclose, or suggest a "portable medium containing the content is removed from the management device while the processing history and the media ID remain in the management device," as discussed above with respect to claim 1. Neither Kim nor Brundrett do either, and thus cannot make up for the deficiencies of either Kuroda or Higashiura with respect to claim 4. Claim 4 is thus also submitted to be allowable. Withdrawal of the rejection of claim 4 is earnestly solicited.

Claim 13:

Claim 13 depends from claim 8 and adds additional distinguishing elements. Neither Kuroda nor Higashiura teach, disclose, or suggest a "second storage unit containing the content is removed from the management device while the processing history and the media ID remain in the management device," as discussed above with respect to claim 1. Neither Kim nor Brundrett do either, and thus cannot make up for the deficiencies of either Kuroda or Higashiura with respect to claim 13. Claim 13 is thus also submitted to be allowable. Withdrawal of the rejection of claim 13 is earnestly solicited

**Conclusion:**

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-16 are allowable over the cited references. Allowance of all claims 1-16 and of this entire application is therefore respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

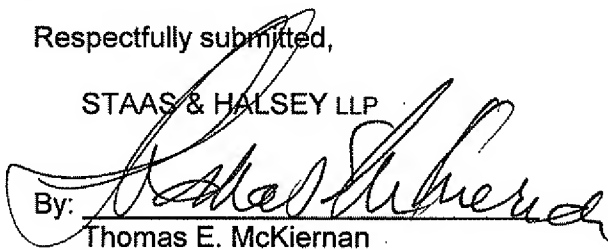
Respectfully submitted,

STAAS & HALSEY LLP

Date:

1/50/07

By:



Thomas E. McKiernan  
Registration No. 37,889

1201 New York Ave, N.W., 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501